

**REMARKS**

Claims 15-58 are pending in this application. By this Reply, claims 15-17, 19, 25, 28, 30, 32, 33, 35, 46 and 54-58 have been amended; and claims 18, 27, 29 and 41-45 have been cancelled. Accordingly, claims 15-17, 19-26, 28, 30-40, and 46-58 are currently at issue.

**A. SUMMARY OF CLAIM AMENDMENTS**

Independent claim 15 has been amended to require a rotating mechanism connected to one of either the laser generator or the lens and a stop that cooperates with the rotating mechanism to define a first operating position and a second operating position. When the rotating mechanism is in the first position the line is projected vertically on the surface, and when the rotating mechanism is in the second position the line is projected horizontally on the surface. Support for this amendment can be found at paragraph 4, 9, 24 and Figs. 3 and 4 of the application. Thus, no new matter has been added.

Independent claim 25 has been amended include a portion of the laser generating assembly being coupled to a rotating member protruding from the housing such that when the rotating member is turned clockwise to its limit, the line on the workpiece will be one of either substantially vertical or substantially horizontal, and when the rotating member is turned counterclockwise to its limit, the line on the workpiece will be the other one of either substantially vertical or substantially horizontal. Support for this amendment can be found at paragraph 4, 9, 24 and Figs. 3 and 4 of the application. Thus, no new matter has been added.

Independent claim 32 has been amended to require a stop that cooperates with the rotating mechanism such that when the rotating mechanism is turned clockwise to its limit the line on the workpiece has an angle of 0 degrees with a reference line and when the rotating mechanism is turned counter-clockwise to its limit the line on the workpiece forms an angle of 90 degrees with the reference line. Support for this amendment also can be found at paragraph 4, 9, 24 and Figs. 3 and 4 of the application. Thus, no new matter has been added.

Independent claim 35 has been amended to include a rotating mechanism having a first stop which prevents rotation of the rotating mechanism in one direction. This defines a first operating position wherein the line on the workpiece forms a first angle with a reference line. A second stop prevents rotation of the rotating mechanism in another direction and defines a second operating position wherein the line of the workpiece forms a second angle with the reference line, the first angle being different from the second angle. Once again, support for this amendment can be found at paragraph 4, 9, 24 and Figs. 3 and 4 of the application. Thus, no new matter has been added.

Independent claim 46 has been amended to include a manually operated rotating mechanism operable on one of either the laser generator or the lens to selectively adjust the line on the surface to be illuminated from an angle between 0 and 90 degrees with the base plane. At least one stop stops the rotating mechanism from adjusting the line on the surface beyond one of either an angle of 0 degrees or 90 degrees with the base plane. Support for this amendment can be found at paragraph 4, 9, 24 and Figs. 3 and 4 of the application. Thus, no new matter has been added.

Independent claim 54 has been amended such that the rotating mechanism includes a stop that cooperates with a fastening member to stabilize the line at one of either 0 degrees or 90 degrees on the surface to be illuminated. Independent claim 55 has been amended to require a fastening member and a magnet that cooperate with one another to maintain the stability of the laser line at 0 degrees and at 90 degrees. Independent claim 56 has been amended such that the manually rotating mechanism is operable on the laser generator assembly to selectively adjust the line on the surface to be illuminated. The manually rotating mechanism has a first stop that defines a first position wherein the line on the surface to be illuminated forms a reference angle of 0 degrees and a second stop that defines a second position wherein the line on the surface to be illuminated has an angle of 90 degrees. Independent claim 57 has been amended to include that the member projecting outwardly from the housing is moveable between a first position wherein the member is rotated counter-clockwise to its limit and the line on the surface to be

illuminated is one of either horizontal or vertical, and a second position wherein the member is rotated clockwise to its limit and the line on the surface to be illuminated is the other of either horizontal or vertical. Independent claim 58 has been amended and requires a laser generator electrically connected to the power supply and positioned inside the housing. The laser generator projects a laser beam through a lens. The lens is manually rotatable with respect to the base of the housing from a first position wherein a first stop prevents further rotation of the lens in a first direction and the laser generator projects a vertical line on a surface to be illuminated to a second position wherein a second stop prevents further rotation of the lens in a second direction which is opposite of the first direction and the laser generator projects a horizontal line on the surface to be illuminated. Support for the amendments to independent claims 54-58 can be found at paragraph 4, 9, 24 and Figs. 3 and 4 of the application. Thus, no new matter has been added.

**B. DECEMBER 14, 2005 OFFICE ACTION**

In the Office Action dated December 14, 2005 (hereinafter "Office Action"), claims 19 and 30 were objected to as being dependent upon a rejected base claim. The Examiner indicated that claims 19 and 30 would be allowable if rewritten in independent form.

In the Office Action, claims 25-29, 31-33, 46, 48 and 55 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,531,031 issued to Green (hereinafter "Green"). Claims 35, 46, 47, 49, 50 54-56 and 58 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,367,779 issued to Lee (hereinafter "Lee"). Claim 34 was rejected under 35 U.S.C. § 103 (a) as being obvious over Green in view of U.S. Patent No. 6,735,879 issued to Malard et al. (hereinafter "Malard"). Claims 35, 46, 47, 49, 50, 54 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Malard. Claims 15-18, 20-24, and 38-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Malard, and further in view of Green. Applicants respectfully traverse these rejections with respect to the claims as amended.

**1. Claim Rejections Under 35 U.S.C. §102(b)**

In order for a reference to act as a § 102 bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983). As shown below, the Applicant respectfully submits that Green does not disclose each and every element of amended claims 25-29, 31-33, 46, 48 and 55. The Applicant also respectfully submits that Lee fails to disclose each and every element of amended claims 35, 46, 47, 49, 50, 54-56 and 58.

**a. Rejection of Claims 25-29, 31-33, 46, 48 and 55 Based On Green**

As an initial matter, each of independent claims 25, 32, 46 and 55 (and their corresponding dependent claims) require a line to be projected onto a workpiece or a surface to be illuminated. Green, on the other hand, employs a laser module assembly 38 which projects a collimated laser beam 36 (See Green, col. 3, ln. 45 through col. 4, ln. 13; See also Figs. 5-8). Thus, rather than forming a line on the desired surface, the device disclosed in Green forms a point or dot. Green does not disclose a device that projects a line or fan-shaped beam on a surface.

Further, independent claims 25, 32, 46 and 55 (and their corresponding dependent claims) of the present invention require: (1) a substantially vertical or horizontal line on the same surface when a rotating member is turned either clockwise or counter-clockwise to its limit (independent claim 25); (2) a line on the workpiece with an angle of 0 degrees with a reference line and 90 degrees with the reference line when the rotating mechanism is turned counter-clockwise to its limit (independent claim 32); (3) to selectively adjust the line on the surface from an angle between 0 degrees and 90 degrees (independent claim 46); and (4) an adjustable line on the surface at 0 degrees with respect to a reference line and 90 degrees with respect to the reference line while maintaining the laser level in a fixed position on a fixed plan (independent claim 55).

Green does not disclose any of the above claim elements of the present invention. Instead, when the laser module assembly 38 disclosed in Green is rotated from one position to a

second position, the laser dot or beam 36 is projected onto a different surface (See Green, Figs. 7 and 8 and col. 4, lns. 3-13).

Finally, Green fails to disclose a fastening member and a magnet that cooperate with one another to maintain the stability of the laser line at 0 degrees and at 90 degrees as required by amended claim 55.

Thus, for the foregoing reasons, the Applicant respectfully submits that claims 25-29, 31-33, 46, 48 and 55 of the present invention are patentable over Green.

**b. Rejection of Claims 35, 46, 47, 49, 50, 54-56 and 58 Based On Lee**

Amended independent claims 35, 46, 56 and 58 call for at least one stop (claim 46) and first and second stops (claims 35, 56 and 58) that: (1) prevents or stops rotation of the rotating mechanism past 0 degrees or 90 degrees (claim 46); or (2) past reference angles of 0 degrees and 90 degrees (claim 56); or (3) past a first operating position having a first angle on the desired surface and a second operating position having a second, different angle on the desired surface (claim 35); or (4) from a first position wherein a vertical line is projected on the surface to a second position wherein a horizontal line is projected on the surface (claim 58). Lee fails to disclose these claim elements. Instead, as shown in Fig. 1, the device in Lee utilizes a rotary socket 33 which holds a diffusing lens 741. The rotary socket 33 sits in a recessed portion 32 (Lee, col. 2, lns. 39-49). The rotary socket 33 can be rotated on flange 35 (Lee, col. 2, lns. 49-51). As shown in Figs. 3 and 4 of Lee and explained at col. 4, lns. 7-23, the rotary socket can be turned around the light concentrator 61. There is nothing to stop the rotation of the rotary socket 33 at any desired positions. Accordingly, the rotary socket 33 in Lee can be rotated a full 360 degrees. Accordingly, Lee does not disclose each and every element of amended claims 35, 46, 56 and 58.

Similarly, amended claims 54 and 55 require a fastening member and a stop to maintain stability of the line at either 0 degrees or 90 degrees on the desired surface. The stop in amended claim 55 is a magnet. As discussed above, Lee the laser line in Lee can be fully rotated about 360 degrees. Lee fails to disclose stops that create discrete operating positions and most

certainly does not disclose the use of fastening members or magnets to stabilize the laser line projected on the desired surface. Thus, the Applicant respectfully submits that claims 35, 46, 47, 49, 50, 54-56 and 58 are patentable over Lee.

## **2. Claim Rejections Under 35 U.S.C. §103(a)**

The law is clear that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Further, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by Examiner. “[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), *citing In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). That motivation cannot come from the Applicant’s invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Thus, unless the references suggest the particular combination of elements themselves, they cannot render Applicant’s invention obvious. *In re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 1374, 28 U.S.P.Q.2d 1801, 1817 (N.D. Ill. 1993).

### **a. Rejection of Claim 34 Based On Green In View Of Malard**

Claim 34 depends from amended independent claim 32. Independent claim 32 has been amended to require a stop that cooperates with the rotating mechanism such that when the rotating mechanism is turned clockwise to its limit the line on the workpiece has an angle of 0 degrees with a reference line and when the rotating mechanism is turned counter-clockwise to its limit the line on the workpiece forms an angle of 90 degrees with the reference line.

As explained above, Green fails to disclose projection of a fan-shaped laser beam to form a line on a surface. Instead, Green discloses a laser module assembly 38 which projects a collimated laser beam 36 (See Green, col. 3, ln. 45 through col. 4, ln. 13; See also Figs. 5-8). Thus, rather than forming a line on the desired surface, the device disclosed in Green forms a point or dot. Further, when the laser module assembly 38 in Green is rotated, it projects the

collimated laser beam 36 onto a different surface (i.e., in one position the laser beam is projected out of a side wall of the housing and in another position the laser beam is projected out of the top wall of the housing). Malard discloses a fan-shaped laser beam to project a line on a surface. Malard does not, however, disclose rotation of the fan-shaped laser beam such that the line can be adjusted on the surface. Thus, the Applicant respectfully submits that the combination of Green and Malard does not disclose, teach or suggest all the elements of claim 34 of the present invention.

**b. Rejection of Claims 35, 46, 47, 49, 50, 54 and 55 Based On Lee In View Of**

**Malard**

As explained above with respect to the 35 U.S.C. § 102 rejections of claims 35, 46, 47, 49, 50, 54 and 55 based on Lee, Lee utilizes a rotary socket 33 which holds a diffusing lens 741. The rotary socket 33 sits in a recessed portion 32 (Lee, col. 2, lns. 39-49). The rotary socket 33 can be rotated on flange 35 (Lee, col. 2, lns. 49-51). As shown in Figs. 3 and 4 of Lee and explained at col. 4, lns. 7-23, the rotary socket can be turned around the light concentrator 61. There is nothing to stop the rotation of the rotary socket 33 at any desired positions. Accordingly, the rotary socket 33 in Lee can be rotated a full 360 degrees. It cannot be prevented from rotating past discrete positions, which correspond to a horizontal line on a desired surface and a vertical line on a horizontal surface. Lee fails to disclose the elements of independent claims 35, 46, 54 and 56 related to the rotational aspect of the laser line.

The addition of Malard fails to address these claim elements as well. Malard discloses a laser level that projects a fan-shaped laser beam to project a line on a desired surface. However, the laser generator in Malard is not rotatable. It is stationary. Lee, even in combination with Malard, fails to disclose, teach or suggest all the claim elements of the present invention. Specifically, Lee in combination with Malard fails to disclose first and second stops (claim 35) and at least one stop (claim 46) that: (1) prevents or stops rotation of the rotating mechanism past 0 degrees or 90 degrees (claim 46); or (2) past a first operating position having a first angle

on the desired surface and a second operating position having a second, different angle on the desired surface (claim 35).

Similarly, Lee in combination with Malard, fails to disclose a fastening member and a stop to maintain stability of the line at either 0 degrees or 90 degrees on the desired surface as required by claims 54 and 55. There is also no disclosure in Lee or Malard of a magnet stop as required by amended claim 55.

Accordingly, the Applicant respectfully submits that Lee in combination with Malard fails to establish a *prima facie* case of obviousness of claims 35, 46, 47, 49, 50, 54 and 55 of the present invention.

**c. Rejection of Claims 15-18, 20-24 and 38-45 Based On Lee In View Of  
Malard and Green**

At paragraph 7 of the Office Action, the Examiner stated:

The device as claimed is disclosed by the combination of Lee and Malard et al together as stated in the rejection recited above for claims 36, 37, 51-53 and 57, but lack the laser module being rotatable relative to the housing. Green teaches rotating the laser module relative to the housing to direct the laser at any desired direction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the laser module of the combination of Lee and Malard et al rotate relative to the housing as taught by Green to direct the laser at any desired direction.

The Applicant respectfully disagrees with the Examiner's conclusion. As explained above, Lee and Malard fail disclose all the elements of claims 36, 37, 51-53 and 57. And the addition of Green fails to address the shortcomings of Lee and Malard. As also explained above, the rotation of the laser module 38 of Green does not rotate the laser line on the same surface as required by claims 15-18, 20-24 and 38-45. Instead, the rotation of the laser module 38 results in the laser beam 36 exiting the top wall 14 of the housing (i.e., perpendicular to the bottom wall 16) rather than through the side wall (i.e., parallel to the bottom wall 16). As a result, the collimated laser beam 36 will be displayed on a different surface.



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Additionally, neither Lee nor Malard nor Green disclose the use of stops to define first and second operating positions wherein the line remains on the same desired surface to be illuminated, but at a different angle (e.g., vertically and horizontally as required by amended claim 15 and at a first and second angles with a reference line as required by claim 35).

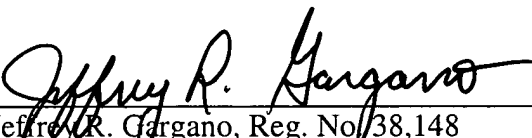
For these reasons, the Applicant respectfully submits that Lee in view of Malard and further in view of Green fails to disclose, teach or suggest each element of claims 15-18, 20-24 and 38-45. Accordingly, the Applicant respectfully submits that claims 15-18, 20-24 and 38-45 are patentable over Lee in view of Malard and Green.

In light of the above amendments and remarks, Applicants believe the pending claims are now in condition for allowance. Reconsideration of these claims is respectfully requested.

If it would expedite the progress of this Application through the examination process, the Examiner is requested to call the undersigned attorney. The Commissioner is authorized to charge any fees associated herewith to Deposit Account No. 23-0280.

Respectfully submitted,

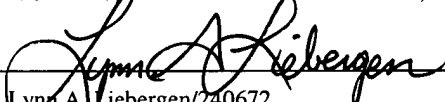
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**CERTIFICATE UNDER (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 14, 2006.

  
Lynn A. Liebergen/240672